

### **REMARKS**

Claims 1-21 are pending and remain rejected. By this amendment, Applicant has amended the drawings and claims and requests reconsideration of this application.

The Examiner objects to the drawings, requiring descriptive labels other than numerical labels for figures 1a(for elements 100, 103-104, 106 & 108), 1b (100 & 103-106), 1c (103,106,108 & 110), 1d (for elements 103, 105 & 109-110) and 2(for elements 200-210).

Applicant has inserted descriptive labels in the attached copies of these figures and submits these for the Examiner's consideration. If the Examiner approves these descriptive labels, Applicant will effect them in the formal drawings.

On page 3 of the office action, the Examiner objected to claims 8 and 18, indicating that the recitation "capable of" does not constitute a positive limitation. Claims 8 and 18 are amended to delete that recitation and recite an alternative positive limitation.

#### ***Section 102 Rejections***

On page 3, in paragraph II, the Examiner rejected claims 1-2 and 4-5 under 35 U.S.C. Section 102(e) as being fully anticipated by the patent 6,374,357 to Mohammed et al.

Claims 1-2 and 4-5 recite the limitations of a host facility and a portable computing device, which are not met by the patent to Mohammed et al. Accordingly, the Examiner is requested to withdraw the rejection under 35 U.S.C. Section 102(e).

#### ***Section 103 Rejections***

In paragraphs III-VI, the Examiner rejects claims 3, 7-13, 15-18, and 20-21 under 35 U.S.C. Section 103(a) as being unpatentable over Mohammed et al., and further in view of the patent to Brody.

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An Examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicant respectfully requests the Examiner to reconsider the bases for the rejections under 35 U.S.C. Section 103 based on the criteria and governing law urged above.

### **CONCLUSION**

In light of the above amendments and remarks, Applicant respectfully requests reconsideration of the rejected claims solicits their allowance. In the event, an interview is

Application No.: 09/727,953  
Reply to Final Office Action of: February 7, 2006

useful in resolving any issues, the Examiner is invited to telephone the undersigned representative.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

Dated: May 15, 2007

By: /ReenaKuyper/  
Reena Kuyper  
Registration No. 33,830

9255 Sunset Blvd., Suite 810  
Los Angeles, CA 90069  
(310) 247-2860